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EXAMINER

SCHUBERT, KEVIN R

ART UNIT PAPER NUMBER

2137

DATE MAILED: 11/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/738,455

Applicant(s)

WU ET AL.

Examiner

Kevin Schubert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8 and 12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8, 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claims 8 and 12 have been considered. The examiner has thoroughly and carefully considered applicant's remarks but maintains the rejection presented in the previous action. The examiner also thanks the applicant for his time and efforts to expedite prosecution on the case through the applicant requested interview conducted 8/23/05.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "wherein said server system establishes a user account identification on said client system" is indefinite. It is unclear whether the establishment is actually done on the client system or whether the server system simply makes an establishment (recognizes a user account) from a user account identification residing on a client system. The examiner believes the latter to be the case. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 8 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Markus, U.S. Patent No. 6,490,601.

As per claim 8, the applicant describes a server system, operable in connection with a central repository of confidential user data, to support the selective distribution of confidential user-information to authorized partner sites on behalf of users of client computer systems, which have specific confidential user data requirements comprising the following limitations which are met by Markus:

a) a connection to a database storing confidential user data within a user account and wherein datums of confidential user data are selectable based on an account identification and server datum identifications (Col 5, lines 29-44);

b) a computer system, coupleable to a communications network and, through said connection, to said database, said computer system being responsive to a network request received from a partner site relative to a client computer system, wherein said network request provides said account identification and said server datum identifications, wherein said server datum identifications have a mapped relationship to the confidential user-information requirements of said partner site with respect to said user account, which is expressed as partner datum identifications, and wherein said computer system supports the determination of said mapped relationship for said partner site and provides for the generation and distribution of a mapped relationship definition to said partner site packaged to be sent as part of said network request in response to a single click on said partner site, wherein said mapped relationship definition implements said mapped relationship in a form evaluateable by said server system upon receipt as part of said network request, to enable said server system to provide a network response to said partner site containing datums of confidential user-information corresponding to said partner datum identifications, wherein said partner datum identifications and corresponding datums of confidential user-information are exclusive of executable code required to be executed by said client computer system (Col 7, line 41 to Col 8, line 5; Col 3, line 38 to Col 4, line 8);

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c) a mapping processor, coupled to receive said mapped relationship definition, that implements combinatorial and logical functions to autonomously convert server datums to partner datums through a process defined by said mapped relationship definition (Col 15, lines 20-53);

Markus discloses a system which meets all the limitations of the above claim except for the limitation "wherein said partner datum identifications and corresponding datums of confidential user-information are exclusive of executable code required to be executed by said client computer system". In Markus' system, shippable code is transferred (Col 11, lines 2-14). The shippable code is transported with user information and used to complete form fields associated with the user information. Thus, Markus' does not disclose "wherein said partner datum identifications and corresponding datums of confidential user-information are exclusive of executable code required to be executed by said client computer system".

However, Markus does disclose in the Background of the Invention section that a method known as the "transactor method" is similar to Markus' instant invention and relies on sending user information that is **not** executable code. As disclosed by Markus, "Another method for assisting a user in filling out an electronic form document is referred to as the "transactor" method... This method differs from the wallet method in that the user is not required to download or install any software onto his or her computer" (Col 3, lines 38-44). Instead of receiving user information and executable code as taught by Markus in his system, the user receives only user information. Fig 2 is an illustration of the "transactor" method in which user information (241 of Fig 2) is received instead of user information and shippable code (324 of Fig 3A) as is the case in Markus' system.

It would have been obvious to one of ordinary skill in the art at the time the invention was filed to combine the ideas of the prior art "transactor" method in Markus' system because sending only the user information reduces needed bandwidth for communication between the repository and the user. For example, this system would be optimal in situations where bandwidth is limited or expensive.

As per claim 12, the applicant describes the server system of claim 8, which is met by Markus, with the following limitation which is also met by Markus:

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Wherein said computer system is coupleable through said communications network to said client system operated by a user, wherein said server system establishes a user account identification on said client system, and wherein said client system autonomously provides said user account identification to said server system in connection with said network request (Col 11, lines 39-49).

Response to Arguments

Applicant's arguments filed 10/24/05 with respect to the 112 rejection of claim 12 have been fully considered but they are not persuasive. The applicant argues that the phrase "wherein said server system establishes a user account identification on said client system" is definite. The examiner disagrees and reiterates his remarks in the previous action. It is unclear whether the phrase "on said client system" refers to the establishing or the user account identification. Though the examiner appreciates applicant's statements, the claim can still be read in two ways. It is unclear whether the establishment is actually done on the client system or whether the server system simply makes an establishment (recognizes a user account) from a user account identification residing on a client system.

Applicant's arguments with respect to the 103a rejection of claim 8 have been fully considered but they are not persuasive. The applicant argues that the claimed invention is patentably distinct from the primary reference, Markus, because the information sent in Markus from the second computer to the first computer is *executable code* whereas the information sent in the claimed invention is *non-executable code*. The examiner has relied on the "transactor method" of Markus' Background of the Invention section in order to show the basic idea that the data may be sent as *non-executable code* instead of *executable code*.

Regarding the applicant's argument that the combination is not enabling, the applicant contends the following:

"To a person of ordinary skill in the relevant art, the transactor process in Markus would sound like a description of an applet-managed data transfer process. Conventional browsers are not known to perform cross-window communications in the absence of some third-party provided program. Applets are well-known to be able to provide the type of processing functions attributed in Markus to the transactor process" (see Remarks, page 2).

The examiner respectfully notes that applicant's statements are not supported by any evidence that the Markus reference is consistent with the above. In contrast, it appears to the examiner that Markus provides no support for applicant's statements that the method "sounds like" an applet-managed data transfer process. Furthermore, assuming arguendo that that applicant's statements are valid and an applet is retrieved as alleged by applicant, the examiner notes that the claimed invention calls for "partner datum identifications and corresponding datums of confidential user-information that are exclusive of executable code required to be executed by said client computer system" (see claim 8 part b). The partner datum identifications and corresponding datums of confidential user-information are, themselves, exclusive of executable code required to be executed by said client system even if an applet is acquired. Thus, even if applicant's statements, which are backed by no evidence or support other than what sounds appropriate to applicant, are correct the examiner respectfully notes that the combination as applied still meets the limitations of the applicant's claim.

Regarding the applicant's argument that the combination does not teach the limitations of the claimed invention, the applicant argues that "a person of ordinary skill in the relevant art, considering the disclosure, would have no idea of what modifications could be made to eliminate the need for or use of Markus' 'shippable' code" (see Remarks page 5). The examiner disagrees with this assertion. The combination as applied is simple and straightforward: instead of sending user information and shippable code, only user information is sent. The examiner fails to appreciate applicant's argument that a person of ordinary skill in the art would have no idea how to send only user information instead of user information and shippable code, especially in light of the examiner's explanation. The combination has been explicitly set forth in the previous action and is clearly prescribed by the relevant passages and Figure of Markus as indicated. The applicant also asserts that "the combined references objectively fail to teach or suggest the use of a mapped relation between server and partner datum identifications" (See Remarks page 5) and that "prior art also fails to teach or suggest the return of the mapped user information to the partner site in any event and certainly not in combination with 'partner datum identifications'" (see Remarks page 5). The examiner disagrees. Even though applicant's allegations fail

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to comply with 37 CFR 1.111(b) because they amount to a general allegation of patentability without specifically pointing out how the language patentably distinguishes the limitations from the references, the examiner nonetheless addresses the applicant's concerns. Markus clearly and explicitly discloses a mapped relation between server and partner datum identifications as a form is completed in accordance with a mapped relation between server and partner datum identifications. The form is returned to the partner site. The examiner urges the applicant to review passages such as Col 7, line 41 to Col 8, line 39 of Markus. The applicant presents yet another argument that the claim presents no requirement that the mapped user information be presented first on the user computer system before being forwarded to the partner site. Assuming *arguendo* that Markus does disclose an additional feature, the examiner fails to see how this argument renders the claimed invention patentable. Markus teaches each and every limitation of the claimed invention.

Regarding the applicant's argument that the combination has no motivation to modify, the applicant argues that there is no adequate or relevant motivation to modify. The examiner disagrees with applicant's assertion. The system of the primary reference, Markus, is one in which the response set of first user information is combined with additional code to form executable code or "shippable code" (Col 11, lines 2-11) (see 324 of Fig 3A). Hence data sent is an augmentation of the first user information as it now contains additional information. As disclosed by the examiner, motivation is realized by the "transactor method", which sends merely the first user information, because the transmission requires less bandwidth, which may be especially relevant in situations where bandwidth is limited or expensive. Hence, the examiner has provided motivation and even a practical situation in which utilization would be pragmatic.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date

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of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Schubert whose telephone number is (571) 272-4239. The examiner can normally be reached on M-F 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KS


MATTHEW SMITHERS
PRIMARY EXAMINER
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